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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,122	12/31/2003	David Eli Wexelblat	06975-460001	1740

26171 7590 09/27/2006

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No.	Applicant(s)	
	10/748,122	WEXELBLAT; DAVID ELI	
	Examiner	Art Unit	
	Prieto Beatriz	2142	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Prieto, Beatriz (Prim Ex). (3) Matt Renner (Reg. No. 41,265).
 (2) Devoto, Roberto J. (Reg. No. 55,108). (4) _____.

Date of Interview: 21 September 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference
 c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
 If Yes, brief description: _____.

Claim(s) discussed: 13.

Identification of prior art discussed: PICKUP (US 2003/0212791) & BROWN (US 20020078158).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Beatriz Prieto
 BEATRIZ PRIETO
 PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

 Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant requested a personal interview faxing required request/agenda (see attached). Applicant requested clarification as to how the prior art was applied and the breadth of the claimed language applied, which were provided by examiner. The issues presented on the agenda were clarified by the examiner which stressed that the language of the claims is extremely broad and that an effort to amend the claims and depart it from the basic email communication technology should be made. A proposed drafted amendment was illustrated to examiner during the interview to which examiner indicated based on a cursory review, it seems to be closer to the inventive concept as presented/indicated by applicant during the interview. The rejection is sustained. Applicant indicated that he will file a request for continued prosecution (RCE) that will hopefull clarify instant application inventive concept. No further agreements were made .


BEATRIZ PRIETO
PRIMARY EXAMINER

Attorney's Docket No.: 06975-460001

OFFICIAL COMMUNICATION FACSIMILE:

EXAMINER BEATRIZ PRIETO

OFFICIAL FAX NO: (571) 273-3902

Number of pages including this page 4

Applicant : David Wexelblat
Serial No. : 10/748,122
Filed : December 31, 2003

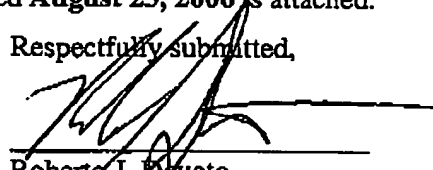
Art Unit : 2142
Examiner : Beatriz Prieto

Title : TRANSACTIONAL WHITE-LISTING FOR ELECTRONIC
COMMUNICATIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

An Applicant Initiated Interview Request Form dated August 23, 2006 is attached.

Respectfully submitted,


Roberto J. Devoto
Reg. No. 55,108

Date: August 23, 2006

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Fax: (202) 783-2331

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PTOL-413A (09-04)
Approved for use through 07/31/2006. OMB 0851-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: 10/748,122 First Named Applicant: David Wexelblat
Examiner: Bentz Prieto Art Unit: 2142 Status of Application: Pending

Tentative Participants:

(1) Roberto Devoto (2) _____
(3) Karl Renner (4) _____

Proposed Date of Interview: 8/29/06 Proposed Time: 2:30 (AM/PM) (PM)

Type of Interview Requested:

(1) ☐ Telephonic (2) ☒ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Rej.</u>	<u>13</u>	<u>Art Pickup - Brown</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:

See Attached sheet

An interview was conducted on the above-identified application on _____

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature

Roberto J. Devoto

Typed/Printed Name of Applicant or Representative

55,108

Registration Number, if applicable

Examiner/SPE Signature

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Attachment to Interview Request Form PTOL-413A for Application No. 10/748,122**Brief Description of Arguments to Be Presented –**

Applicant asserts that Pickup and Brown, either alone or in combination, do not describe or suggest at least the following feature of claim 13 - "receiving an out-of-band communication from a service provider over an out-of-band communication channel, the out-of-band communication identifying an expected e-mail sender different than the service provider and identifying an intended e-mail recipient and the out-of-band communication being received by a communications service provider associated with the intended e-mail recipient, where communications from the expected e-mail sender are sent over a communication channel other than the channel through which the out-of-band communication was received".

Applicant wishes to conduct an interview with Examiner Prieto to gain an understanding of the reasoning behind her assertion that the combination of Pickup and Brown discloses this feature. Applicant believes that such an interview is essential to clarify issues, thereby enabling decisions on the most appropriate steps to be taken in constructively advancing prosecution of this case (e.g., submission of clarifying amendments through a continued examination or submission of an appeal).

Specifically, the Final Office Action seems to suggest that an e-mail sent by a user working on user PC 312 meets the recited "out-of-band communication" and that the outbound path 315 over which the e-mail is communicated from the user PC 312 to the server 320 (as shown in Fig. 4 of Brown) meets the recited "out-of-band communication channel." See page 19, lines 17-22. Considering this construction in light of the following claim limitation, "receiving an out-of-band communication from a service provider over an out-of-band communication channel" (emphasis added), the Final Office Action appears to be suggesting that the recited "service provider" is met by a user working on user PC 312 that sends the e-mail, and appears to be asserting that the mail server 320, which receives the e-mail from the user working on user PC 312 over the outbound path 315, is the entity that is performing the recited operation of "receiving an out-of-band communication from a service provider over the out-of-band communication channel" (emphasis added).

The Final Office Action, however, then asserts, in reference to the Microsoft Outlook art, that the recited "service provider" is no longer the user of user PC 312, but rather is now the mail

server 320 and that the entity that is "receiving the out-of-band communication" is no longer the mail server 320 but rather is now the recipient 342. See page 20, line 12, to page 21, line 7. If our understanding of the positions set forth in the Final Office Action is correct, these limitations would seem to be addressed in an inconsistent manner by the Final Office Action. Applicant believes that an interview may be useful to obtain clarity on this point.

Moreover, the Final Office Action does not seem to address the following recited limitation: "the out-of-band communication [which is received from a service provider over an out-of-band channel] being received by a communications service provider associated with the intended recipient" (emphasis added). Applicant hopes that an interview might also be useful in understanding how the Examiner believes that this limitation has been satisfied by the cited combination of references.

Ultimately, applicant seeks to limit its requests for appeal to cases where applicant and the Examiner have a clear and mutual understanding of each other's positions, and yet disagree. Here, no mutual understanding exists because applicant remains unclear about the reasoning used in setting forth the pending rejections. Applicant requests this interview as a means of seeking mutual understanding, and thus, determining whether this case represents an appropriate utilization of the appeal process, or if instead further clarifying amendments are appropriate.